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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,209	02/25/2004	Alejandro Dee	10004.512	3041

39231 7590 04/14/2006

SMITH LAW OFFICE  
440 SCIENCE DR.  
SUITE 302  
MADISON, WI 53711

EXAMINER

LEVY, NEIL S

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/786,209	DEE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	NEIL LEVY	1615	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/10/06 30-06</u>   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 -28 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

The claims) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection of record is maintained - There is no sorbitol in

the specification. Alcohols are listed as ethanol or propanol, and other solvents do not include sorbitol, nor any other sugar alcohol - Reading the specification would not lead one to sorbitol - The specification can not be amended, because this is a straight continuation, not a c.i.p.. This rejection is maintained unless applicant can point to sorbitol in the specification. Applicants' comment on dielectric constants is not appreciated as a basis for generating sorbitol in claims - this argument provides for any lipophilic polar solvent (claim 17) compound above 25 –

There is no support in the specification for any fatty acid esters, thus specifying the presence of some amount of esters, but not enough to improve the antimicrobial activity is also totally unsupported. Further, it is not at all clear what would constitute an improvement; & if there was one, what would constitute a substantial quantification of such improvement.

The rejection of record is maintained. Not a word is evident to this examiner, in the disclosure, referring to esters, by comparison or otherwise. Exclusion is thus by utilizing "consisting of" language.

Applicant's arguments filed 2/10/06 have been fully considered but they are not persuasive. Applicant's arguments in essence are that since the specification states high dielectric constants are desirable, any solvent material can thus be specifically introduced into a claim as a representative compound. The argument for exclusion of improving amounts of fatty acid esters is that applicant wishes to get around the art that so specifies these ingredients; noting that there is no mention of esters in the instant specification.. examiner holds to the position that these are not sufficient bases to introduce new matter into the claims; the negative limitation of something not explicitly identified in the specification on the one hand, & inclusion of a compound not explicitly identified in the specification on the other- applicant is suggested to consider this case as a CIP; if these limitations are removed, the prior art of record will again be applied. At present, we agree with applicant that fatty acid esters are required in the reference.


We also find the description of dielectric constants; but not of sorbitol.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEIL LEVY whose telephone number is 571-272-0619. The examiner can normally be reached on Tuesday-Friday, 7 AM to 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
NEIL LEVY  
Primary Examiner  
Art Unit 1615

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